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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/420,887	10/19/1999	PUTHIYA K. NIZAR	042390.P7149	3400

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EXAMINER
ROBERTSON, DAVID L

ART UNIT	PAPER NUMBER
2186	8

DATE MAILED: 09/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PRE

Office Action Summary	Application No.	Applicant(s)	
	09/420,887	NIZAR ET AL.	
	Examiner	Art Unit	
	David L. Robertson	2186	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 August 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

This Office action is in response to the Response filed August 22, 2003.

The examiner notes that applicants have declined to copy the claims of Ryan. Note that applicants have argued that their invention differs from that of Ryan. While that may in fact be the case, the Ryan application and the present application are nevertheless claiming the "same invention." Therefore, applicants have disclaimed the invention suggested by the claim (see 37 C.F.R. § 1.605(a), note that "same invention" is defined in § 1.601(n)).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-23 are rejected under 35 U.S.C. 102(e) as being anticipated by either Ryan (US 2001/0042163 A1) or Ryan (US 6,449,679 B2). The particulars of the rejection can be found in the previous two Office actions and are incorporated herein by reference.

Claims 1-23 are rejected under 35 U.S.C. 102(a) as being anticipated by "SDRAM to Direct RDRAM" (hereafter the *presentation*). The particulars of the rejection can be found in the previous Office action and are incorporated herein by reference.

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ingenio *et al.* (US 6,041,361). The particulars of the rejection can be found in the previous Office action and are incorporated herein by reference.

Applicants' arguments filed August 27, 2003 have been fully considered but they are not persuasive. With respect to the § 102(e) rejection, applicants have attempted to distinguish their invention from that of Ryan by stating that the "protocol used between the MCH and the MTH is different from the memory channel protocol." However, this distinction is conspicuously absent from the claims. The claims recite a memory translation hub that receives a memory control packet from the memory channel and which then generates memory control signals on the memory bus. This is exactly what the Ryan reference does. Thus, the claims are anticipated. With respect to the § 102(a) rejection, the presentation was submitted by Ryan during the prosecution of the US 6,449,679 application, and is but a single page. It would appear that since the reference is no longer found in the file wrapper, both the file copy and applicant copy were mailed to applicants; any confusion that this may have caused is regretted. Applicants suggest, but do not provide any evidence, that the publication may be directed to applicants' invention. However, no assertion as to when the publication may have been printed has been made, thus

there is no certainty that the publication was made within one year of applicant's filing. Further, it would seem that in view of applicants' remarks (that to date applicants have not been able to identify any particulars concerning the publication) that both the authorship and publication must indeed be attributable to others, therefore it properly applies as prior art under § 102(a). Further, applicants' arguments are based on mere speculation. The examiner is not going to withdraw the rejection on such grounds. With respect to the § 103 rejection, applicants allege that the Ingenio teaching is limited to combining a known memory controller to a known memory device. This argument is specious. The reference is open-ended and teaches making an otherwise incompatible memory connection. Clearly both the incoming and outgoing protocols must be known in order to construct either a device as taught by Ingenio or one as claimed by applicants, even if the protocols be novel. Applicants' claims do not recite any of the particulars of the protocol; therefore the rejections are proper and have not been overcome.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to David L. Robertson at telephone number (703) 305-3825.

David L. Robertson
Primary Examiner
Art Unit 2186